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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,522	07/22/2003	Hiroshi Yamashita	240629US0	5821

22850 7590 06/20/2005

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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GOODROW, JOHN L

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 06/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/623,522

Applicant(s)

YAMASHITA ET AL.

Examiner

John L. Goodrow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-106 is/are pending in the application.
- 4a) Of the above claim(s) 59-106 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election with traverse of Group I in the reply filed on 3/22/05 is acknowledged. The traversal is on the ground(s) that the Examiner has not carried out the burden of providing sufficient reason and/or examples to support any conclusion that the claims of the restricted groups are not patentably distinct. This is not found persuasive because the method of making the toner either suspension or emulsion polymerization with a second surfactant is different from the apparatus, the cartridge, the transfer method and the development method.

The requirement is still deemed proper and is therefore made FINAL.

***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamashita et al "972" in view of Cheng et al "691" Muto et al "901" and Ohmura et al "122".

Applicants' invention is to a second surface-active agent that changes the electrostatic property of the toner due to the first surfactant i.e. dispersing agent note page 7 of

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applicants' specification. " Accordingly, average charge level of the obtained toner is low, charging speed for the toner is slow, and the toner is strongly affected by humidity. " Yamashita et al "972" teaches the method of preparing toner particles by dispersing and heating particles in the presence of a surface active agent with a polarity opposite to that of the polarity on the surface of the toner particles. Col. 13 has a fluoroalkyl-group-containing surface-active agent. The use by the skilled worker of a surfactant, a surface active agent, a dispersion agent and a charge control agent in the control of the charging ability of the toner is shown by Ohmura et al note Col. 12 line 20-25 where a surface active agent is employed mainly as an emulsifier. Cheng et al Col.7-8 teaches the use of chain transfer agents in an emulsion polymerization that prevent the polar groups from the surface of the toner particle. Col. 8 lines 55-60 such agents can reduce the number of such polar groups that are chemically bound to the surface of the resin particle. Muto et al teaches the use of a fluoroalkyl-group-containing quaternary ammonium salts to control the formed particle. Col.12 lines 30-45 " Chargeable finely-divided resin particles having dissociable functional groups at the surface thereof are generally highly hydrophilic, so that the charge quantity thereof decreases at high temperatures and high humidities. However, by allowing a fluorine containing quaternary ammonium salt to react with the anionic group, stable, high negative chargeability can be obtained, without the charge quantity being decreased, even at high temperatures and humidities." It would be obvious to one of ordinary skill in the art at the time of applicants' invention with a reasonable expectation of success to use the

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known agents that can decrease the surface polar groups on a toner to provide an improvement to the chargeability of the toner.

Claims 29-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamashita et al "972" in view of Muto et al, Cheng et al and Emoto et al. The references are applied as above with the new reference Emoto et al teaching that it is known to remove the organic solvent from a polarization process in the method of manufacturing a toner. It would be obvious to one of ordinary skill in the art at the time of applicants' invention with a reasonable expectation of success to use the known methods of manufacturing a toner that can have the polar groups on the surface neutralized by an opposite polar group that improves the chargeability of the toner.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-58 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 10/876718. Although the conflicting claims are not identical, they are

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not patentably distinct from each other because both teach the method for preparing a toner with the mixing of a surfactant having a second polarity different from the first that is on the surface of the toner constituent particle.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1-58 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No 10/871580. Although the conflicting claims are not identical, they are not patentably distinct from each other because the functional particulate organic material can be a toner and the use of a fluorine-containing surfactant removes the polar group on the surface of the particle.

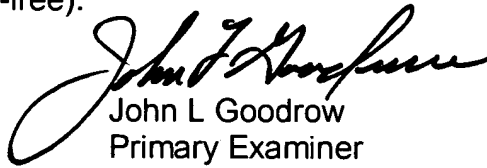
This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Goodrow whose telephone number is 571-272-1384. The examiner can normally be reached on Monday -Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark F. Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
John L. Goodrow  
Primary Examiner  
Art Unit 1756

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